



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/741,388	12/20/2000	Christopher F. Claiborne	20282DA	6177

210 7590 11/05/2003

MERCK AND CO INC
P O BOX 2000
RAHWAY, NJ 070650907

EXAMINER

MORRIS, PATRICIA L

ART UNIT	PAPER NUMBER
----------	--------------

1625

DATE MAILED: 11/05/2003

10

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/741,388

Applicant(s)

Claiborne et al

Examiner

P. Morris

Group Art Unit

1625

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 7-23-02
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1, 2 and 4-13 is/are pending in the application.
- Of the above claim(s) 5-13 is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1 is/are rejected.
- ☒ Claim(s) 2 and 4 is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

Art Unit: 1625

DETAILED ACTION

Claims 1, 2 and 4 are under consideration in this application.

Claims 5-13 are held withdrawn from consideration as being drawn to nonelected subject matter 37 CFR 1.142(b).

Election/Restriction

Applicants' election with traverse of Group I in Paper no. 8, filed July 23, 2002, is acknowledged. The traversal is on the ground that there is no serious burden on the examiner to search all the inventions. This is not found persuasive for the reasons clearly set forth in Paper no. 3.

Claims 6-12 are restricted out in a separate Group, as they are really multiple processes of using. MPEP 806.05(h) provides for restricting out such use claims where it can be established that the compounds have more than one use which is evidenced by applicants' own claims and specification.

The restriction requirement is deemed sound and proper and will be maintained.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 1 is rejected under 35 U.S.C. § 112, first paragraph, as the claimed invention is not described in such full, clear, concise and exact terms as to enable any person skilled in the art to make and use the same, which applicant regards as the invention.

Art Unit: 1625

The term aralkyl in the R^3 group, is not limited from infinity in its carbon size. Very large hydrocarbons would be waxes, which would make them unacceptable for pharmaceutical preparations.

Aralkyl could be read as aromatic. Some aromatic groups are heterocyclic. Therefore, the indefiniteness of claim 1 causes overlap.

Applicants claim all aralkyl radicals in R^3 . Applicants' exemplification cannot be seen to provide adequate representative support for such a claim.

There are no carbon limits on aralkyl in the claim.

The definition of aryl is varied, note the footnotes on pages 134 USPQ 301-304 of In re Sus, for multiple varied definitions of aryl.

Therefore, applicants need to indicate in the claims what they intend by aralkyl.

All aralkyl radicals are not supported in the specification, yet they are claimed here. Applicants could resolve this point in the claim by indicating that aralkyl is benzyl, etc.

Markush listing of specific intended, producible rings for aralkyl is suggested in claim 1.

One should be able, from a reading of the claims, determine what that claim does or does not encompass.

Why? Because that claim precludes others from making, using, or selling that compound for 20 years. Therefore, one must know what compound is being claimed.

In the pharmaceutical area, declarations under 37 CFR 1.132 are often employed to set forth the advantage of a particular substituent. The definition and claiming of substituents is extremely important in the claims of the application. Applicants should not be able to preempt future work of others by means of claims to compounds they themselves did not make and test.

Art Unit: 1625

The written description is considered inadequate here in the specification.

Conception of the intended aralkyl groups should not be the role of the reader.

Applicants should, in return for a 20 year monopoly, be disclosing to the public that which they know as an actual demonstrated fact. The disclosure should not be merely an invitation to experiment. This is a 35 USC 112, first paragraph. If you (the public) find that it works, I claim it, is not a proper basis of patentability. In re Kirk, 153 USPQ 48, at page 53.

The unknown aralkyl variable is not believed to meet the requirements of 35 USC 112, first and second paragraph. These unknown aralkyl groups could easily alter the utility.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The expression "where applicable" is indefinite to its meaning. How is applicability determined?

Priority

Applicants are requested to update the status of the parent application, Ser. No. 09/358,199, on page 1 of the specification. Cooperation herein is appreciated.

Art Unit: 1625

Allowable Subject Matter

Claims 2 and 4 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

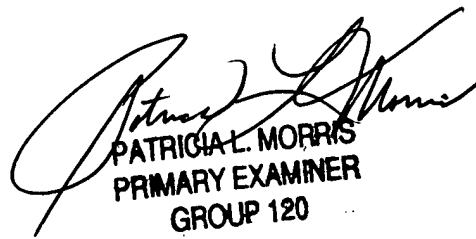
Claim 1 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112 set forth in this Office action.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ms. Morris whose telephone number is (703) 308-4533.

plm

October 31, 2003


PATRICIA L. MORRIS
PRIMARY EXAMINER
GROUP 120